

Application No. 09/626,636  
Amendment dated March 26, 2004  
Reply to Office Action of December 17, 2003

### **REMARKS**

Applicant submitted an Information Disclosure Statement (IDS) on July 27, 2000 with Form PTO-1449, and an IDS on September 23, 2003 having a table on page 2 entitled "Not For Publication." To date, Applicant has not received either of these documents with the Examiner's initials indicating their consideration by the Examiner. Applicant respectfully requests the Examiner to indicate that each entry on these documents was considered by marking the appropriate column under the heading "Examiner Initial" and return a copy of each document to the Applicant with the next action.

Applicant amended claims 172, 176, 177, and 191, and added new claims 247-330 to further define Applicant's claimed invention. New claims 247-264, 270-275, 281-284, 289-312, and 323-326 read on Species 1 of the Restriction Requirement of July 25, 2003. Applicant consents to the withdrawal of claims 265-269, 276-280, 285-288, 313-322, and 327-330 as reading on a non-elected species. Applicant respectfully requests the rejoinder of claims 265-269, 276-280, 285-288, 313-322, and 327-330 upon the allowance of independent claims 248 and 289.

In the Office Action, the Examiner indicated that claims 176, 218 and 214 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicant rewrote claim 176 in independent form without the recitation that the guard has "a wall that is continuous around the mid-longitudinal axis of said guard," which Applicant submits is unnecessary for the patentability of the claim.

The Examiner rejected claims 172-175, 177-184, 190, 201, 202, 207-213, 215-217, 219-226, 237, and 238 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,049,150 to Cozad.

Independent claim 172 as now amended recites an apparatus including a guard having a distal end that is "contoured to the curvature of the adjacent vertebral bodies." Cozad teaches a cylindrical sleeve for use with a hip joint. (Cozad, col. 1, lines 50-51;

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Figs. 1 and 2). Cozad does not teach or suggest an apparatus as recited in Applicant's claimed invention.

Independent claim 207 recites an apparatus including a guard having "openings in said sides." The Examiner contends that Cozad discloses openings in the sides "between the teeth (36), the cap (20) or means for receiving an impaction force, footplate (40)." (Office Action, page 2, item 4, second paragraph). Applicant respectfully traverses the Examiner's contention. As shown in Fig. 1, the sides of sleeve 30 are solid. (Cozad, Fig. 1). Nowhere does Cozad teach or suggest "openings in said sides" as recited in independent claim 207.

Applicant submits that independent claims 172 and 207 are patentable and that dependent claims 173-175, 177-184, 190, 201, 202, 208-213, 215-217, 219-226, 237, 238, and 247 dependent from one of independent claims 172 and 207, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

Applicant also submits that claims 248-330 are patentable over the cited art. Independent claim 248 recites a hollow tubular guard having a passage with "an inner diameter of at least 16.5 mm." Independent claim 289 recites a hollow tubular guard having a passage with "an inner diameter of at least 16.5 mm" and "openings in said sides." Cozad teaches a tool for removing a femoral head. (Cozad, col. 1, lines 30-34). Cozad does not teach or suggest a guard as recited in independent claims 248 and 289. Accordingly, Applicant submits that independent claims 248 and 289 are patentable and that dependent claims 249-288 and 290-330 dependent from one of independent claims 248 and 289, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the amendments to the claims and preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees

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due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

MARTIN & FERRARO, LLP

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By: Thomas H. Martin  
Thomas H. Martin  
Registration No. 34,383

1557 Lake O'Pines Street, NE  
Hartville, Ohio 44632  
Telephone: (330) 877-0700  
Facsimile: (330) 877-2030